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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,395	06/20/2000	Michael J. Natan	PSU 00 2182A	6068
25871	7590	06/30/2004	EXAMINER	
SWANSON & BRATSCHUN L.L.C. 1745 SHEA CENTER DRIVE SUITE 330 HIGHLANDS RANCH, CO 80129			MARSCHER, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,395

Applicant(s)

NATAN ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/10/03, 1/13/04, & 4/13/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 15-17 and 87-96 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10, 16, 17, & 87-96 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date (3 sheets)
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date 10/16/03.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments; filed 10/10/03, 1/13/04, and 4/13/04; have been fully considered and they are deemed to be persuasive to overcome previous rejections of record. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Unfortunately, upon reconsideration, the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 7-10, 16, 17, and 87-96 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Martin et al. [Adv. Materials, Vol. 11, No. 12, pp. 1021-1025 (1999); already of record].

Upon reviewing the date of publication of the above Martin et al. reference, it has been found, albeit regrettable only lately, that its publication date online was August 18, 1999, which predates even the earliest instantly filed priority documents. It is also noted that the authorship of said Martin et al. reference differs from the instantly filed application inventorship and thus supplies evidence that the invention was known or used by others in this country before the invention by the instant applicants. The reference describes freestanding rod-shaped particles which fall within the

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characteristics ranges as instantly claimed. On page 1022, first column, the rod diameters (widths as instantly claimed) are 200 – 300 nm. The lengths are defined by the 1 C of Au equal to approximately 4 C of Pt which in turn equals about 1.3  $\mu\text{m}$ . On page 1023 in Figure 1 and in the bridging paragraph between pages 1023 and 1024 freestanding particles of 1 C Au/8 C Pt/2 C Au of this type are disclosed which calculates to particle lengths of about 5.2  $\mu\text{m}$ . The process steps of instant claim 88 for such particle species is disclosed in Figure 4 and associated discussion on page 1021 of the reference thus also clearly anticipating the instant product by process claims. This rejection may be overcome by the filing of either a Katz type Declaration under 37 CFR § 1.132 explaining the inventorship of only the instantly set forth inventors vs. the authorship of this reference or via a Declaration under 37 CFR § 1.131 predating the reference.

Claim 15 is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

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Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

June 28, 2004

*Ardin H. Marschel*  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER 6/28/04